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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Rush et al.
Title: Device and Method Employing Shape Memory Alloy
Patent No.: 6,916,159 *B2* Issue Date: July 12, 2005
Application No.: 10/683,659 Filing Date: October 9, 2003
Examiner: Timothy P. Solak Group Art Unit: 3746
Docket No.: THER.008US1 Conf. No.: 1810

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 7/27/05

Signature

Gulien Bower

Attn: Certificate of Correction Branch Of The Patent Issue Division
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

**Certificate
AUG 02 2005
of Correction**

REQUEST FOR ENTRY OF CERTIFICATE OF CORRECTION

Sir:

Please enter the enclosed Certificate of Correction (PTO Form 1050) in the above patent.

The error sought to be corrected was made by

☒ the Patent and Trademark Office. Thus, no fee is required for the Certificate of Correction pursuant to 37 CFR §1.322.

☐ Applicant(s) (at least in part). See next section for explanation. The appropriate fee under 37 CFR §1.323 has been authorized below.

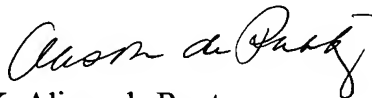
Please correct the following error made by the USPTO:

On the front page, under the heading "Related U.S. Application Data," please delete the phrase "provisional application No. 60/424,414, filed on Nov. 6, 2002,".

An Amendment to correct the Related U.S. Application Data was filed with the USPTO on December 2, 2004. Copies of pertinent pages of the Amendment and the postcard stamped received by the USPTO is attached.

Please direct all inquiries concerning this request to the undersigned attorney at (415) 318-1160.

Respectfully submitted,



K. Alison de Runtz
Reg. No. 37,119

Parsons Hsue & de Runtz LLP
655 Montgomery Street, Suite 1800
San Francisco, CA 94111
(415) 318-1160
(415) 693-0194 (Fax)

MAIL STOP AMENDMENT
COMMISSIONER FOR PATENTS
P.O. BOX 1450
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SEP 13 2004

PATENTS

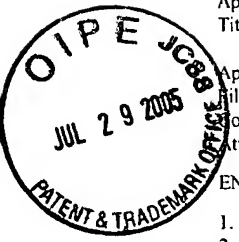
Applicants: Rush et al.
Title: Pumping Device, System and Method Employing a Shape Memory Alloy (As Amended)
Application No.: 10/683,659
Filing Date: 10/9/03
Conf. No.: 1810
Atty Docket No.: THER.008US1

ENCLOSED:

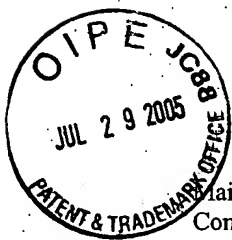
1. This Return Receipt Postcard
2. This Transmittal Letter (in duplicate - 1 page)
3. Amendment and Attachments (22 pages)
4. Petition for Extension of Time (Two-Month) (2 pages)
5. Supplemental Information Disclosure Statement (2 pages)
6. PTO Form 1449 (1 page)
7. Check for \$1078.00

ADR/edb

Mailing Date: 12/2/04
Due Date: 10/2/04



AUG 03 2005



December 2, 2004

Mail Stop Amendment

Commissioner For Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Re: Applicant(s):

Rush et al.

Title:

Pumping Device, System and Method Employing a Shape Memory Alloy
(As Amended)

Application No.: 10/683,659

Filing Date: October 9, 2003

Examiner: Timothy P. Solak

Group Art Unit: 3762

Docket No.: THER.008US1

Conf. No.: 1810

Dear Sir:

Transmitted herewith are the following documents in the above-identified application:

- (1) Return Receipt Postcard;
- (2) This Transmittal Letter (in duplicate - 1 page);
- (3) Amendment and Attachments (22 pages);
- (4) Petition for Extension of Time (Two-Month) (1 page);
- (5) Supplemental Information Disclosure Statement (2 pages);
- (6) PTO Form 1449 (1 page); and
- (7) Check for \$1078.00.



No additional fee is required.



The fee has been calculated as shown below:

CLAIMS AS AMENDED

	Claims Remaining <u>After Amendment</u>		Highest No. Previously <u>Paid For</u>		Present <u>Extra</u>		<u>Rate</u>		Additional <u>Fee</u>	
Total Claims	46	Minus	20	=	26	x	\$18.00	\$	468.00	
Independent Claims	3	Minus	3	=	0	x	\$88.00	\$	0.00	
<input type="checkbox"/>	Fee of _____ for the first filing of one or more multiple dependent claims per application								\$	
<input checked="" type="checkbox"/>	Fee for Petition for Extension of Time (Two-Month)								\$	430.00
<input checked="" type="checkbox"/>	Fee for Supplemental Information Disclosure Statement								\$	180.00
<u>Total additional fee for this Amendment:</u>								\$	\$1078.00	

- ☒ Conditional Petition for Extension of Time: If an extension of time is required for timely filing of the enclosed document(s) after all papers filed with this transmittal have been considered, an extension of time is hereby requested.
- ☒ Please charge any additional fees required and credit any overpayment to our Deposit Account No. 502664.

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Kileen Bowen
Signature

Respectfully submitted,

K. Alison de Runtz

K. Alison de Runtz
Reg. No. 37,119



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Rush et al.
Title: Pumping Device, System and Method Employing a Shape Memory Alloy (As Amended)
Serial No.: 10/683,659 Filed: October 9, 2003
Examiner: Timothy P. Solak Group Art Unit: 3746
Docket No.: THER.008US1 Conf. No.: 1810

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Signature Gilbert Bower

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:

This is in response to an office action that was mailed on July 2, 2004 and set a shortened statutory period for response that expired on October 2, 2004. A request for a two-month extension of time is submitted herewith. In view of the following amendments and remarks, reconsideration is respectfully requested.

AMENDMENT TO THE SPECIFICATION

In the Specification:

Please delete the title on line 1 of page 1 and line 1 of page 21 of the specification and replace it with the replacement title set forth below, which is marked to show the changes being made.

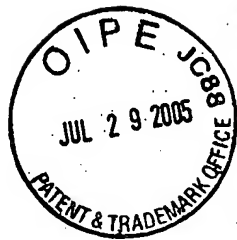
~~FLUID DELIVERY~~ PUMPING DEVICE, SYSTEM AND METHOD
EMPLOYING A SHAPE MEMORY ALLOY

Please delete line 2 of page 1 of the specification and replace it with the replacement text set forth below, which is marked to show the changes being made.

Inventors: Benjamin M. Rush and Christopher V. Reggiardo.

Please delete paragraph [0001] on page 1 of the specification and replace it with the replacement paragraph set forth below, which is marked to show the changes being made.

[0001] This non-provisional application is related to and claims priority based on U.S. Provisional Application No. 60/417,464, entitled "Disposable Pump For Drug Delivery System," filed on October 9, 2002, and U.S. Provisional Application No. 60/424,613, entitled "Disposable Pump And Actuation Circuit For Drug Delivery System," filed on November 6, 2002, and ~~U.S. Provisional Application No. 60/424,414, entitled "Automatic Biological Analyte Testing Meter With Integrated Lancing Device And Methods Of Use,"~~ filed November 6, 2002, each of which is incorporated herein in its entirety by this reference. This non-provisional application is also related to U.S. Provisional Application No. 60/424,414, entitled "Automatic Biological Analyte Testing Meter With Integrated Lancing Device And Methods Of Use," filed November 6, 2002, and U.S. Patent No. 6,560,471, entitled "Analyte Monitoring Device and Methods of Use," issued May 6, 2003, each of which is incorporated herein in its entirety by this reference.



REMARKS

The Examiner's indication that all of the items listed on Form PTO-1449 of the Information Disclosure Statement of April 27, 2004 have been considered is acknowledged and much appreciated.

The Examiner objected to Figures 1A, 2A, and 7, a portion of paragraph [0045] of the specification, and the title set forth in the specification. It is believed that the amendments and remarks herein regarding Figures 1A, 2A and 7, and associated portions of the specification, paragraph [0045], and the title set forth in the specification, appropriately address the Examiner's objections. Other amendments to the Figures and the specification are also remarked upon below.

The Examiner objected to the title set forth in the specification. The specification has been amended to replace the title with a new title, which is believed appropriate in that the claims are directed to a pumping device or system (see new Claims 11-48) and a method of pumping (see new Claims 49-51 and new Claims 52-56), each of which employs a shape memory alloy.

The specification has been amended to replace text concerning the inventors with text that reflects the middle initial of one of the inventors.

The specification has been amended in paragraph [0001] to reflect a claim of priority to only two provisional applications. The reference to a third provisional application and its incorporation by reference is maintained, but this third provisional application is not a basis for the claim of priority. No new matter has been added by virtue of this amendment.

The specification has additionally been amended in paragraph [0008] to correct an obvious typographical oversight. No new matter has been added by virtue of this amendment.

The specification has been amended in paragraph [0037] to refer to reference numbers for the cylindrical bore and the piston discussed in paragraph [0037] and shown in Figure 2A, as is consistent with the replacement Figure 2A, as further discussed herein. No new matter has been added by virtue of this amendment.

The specification has additionally been amended in paragraph [0045] to correct various oversights concerning the reference numbers that originally appeared in that paragraph.

The specification has been further amended in paragraph [0047] to refer to the remainder of the first alternative embodiment of the invention, as shown in Figure 7. As



It is believed that all of the objections to the drawings and to the specification have been appropriately addressed.

The claims have been amended to cancel original Claims 1-10 and add new Claims 11-56, which are directed to subject matter that Applicants regard as their invention. No new matter has been added by virtue of these amendments.

Former Claims 1, 2, 4, 5 and 7 were rejected under 35 U.S.C. 102(b), as allegedly being anticipated by U.S. Patent No. 5,62,482 to Lee (hereinafter, "Lee"). Former Claim 8 was rejected under 35 U.S.C. 102(b), as allegedly being anticipated by U.S. Patent No. 6,085,871 to Karamata (hereinafter, "Karamata"). Former Claims 9 and 10 were rejected under 35 U.S.C. 102(b), as allegedly being anticipated by Lee. Former Claims 3 and 6 were rejected under 35 U.S.C. 103(a), as allegedly being unpatentable over Lee. Each of the foregoing rejection is moot in view of the cancellation of the former claims. In view of the mootness of the above-mentioned rejections, no comments on any of same or any statement in support of same are necessary or provided herein.

New Claims 11-56 are believed to be patentable over each of Lee and Karamata. Each of Lee and Karamata fails to teach or suggest a device for pumping a predetermined volume of fluid that comprises a combination of elements as recited in new Claims 11-48, and fails to teach or suggest a method of pumping a predetermined volume of fluid that comprises a combination of elements as recited in new Claims 49-51 and 52-56.

CONCLUSION

Claims 11-56 define novel and non-obvious subject matter of the present invention. Therefore, an early notification that the application is in condition for allowance is earnestly solicited.

Respectfully submitted,

K. Alison de Runtz
Reg. No.: 37,119

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UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO. : 6,916,159 *B2*
ISSUE DATE : July 12, 2005
INVENTOR(S) : Rush et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Front page, under the heading "Related U.S. Application Data," please delete the phrase "provisional application No. 60/424,414, filed on Nov. 6, 2002,".

MAILING ADDRESS OF SENDER:

K. Alison de Runtz
PARSONS HSUE & DE RUNTZ LLP
655 Montgomery Street, Suite 1800
San Francisco, California 94111

PATENT NO. 6,916,159 *B2*



This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 and select option 2.

AUG 03 2005